

### **REMARKS**

Applicant respectfully requests reconsideration. Claims 1-39 were previously pending in this application with claims 28-39 being withdrawn from consideration. Applicant has amended claims 1-3, 20-23, and 25. No new matter has been added. Claims 1-27 are now pending for examination, with claims 1, 26 and 27 being independent.

#### **Rejection of Claims 1-25 and 27 Under 35 U.S.C. §112**

Claims 1-25 and 27 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Office Action states that the claims are confusing and unclear by not requiring the fluid applied to the surface to contain a material that is subsequently allowed to deposit. Claims 1-3 have been amended for clarity in a manner that is not narrowing and which is believed to overcome this rejection.

The Office Action also states that claims 1 and 2 are confusing for the reasons stated in the office action. Claims 1 and 2 have been amended for clarity in a manner that is not narrowing and which is believed to overcome this rejection.

The Office Action states that claim 2 is unclear where the second material deposits on the substrate. As noted above, claim 2 has been amended in a manner which is believed to overcome this rejection.

The Office Action also states that claims 20-23 are unclear by requiring the recess or protrusion to comprise a plurality of recesses or protrusions. Claims 20-23 have been amended for clarity, in a manner that is not narrowing and which is believed to overcome this rejection.

For the above-noted reasons, Applicant respectfully requests withdrawal of the claim rejections based on these grounds.

#### **Claim Rejections Under 35 U.S.C. §103**

Claims 1-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ostuni, et al. (U.S. Patent No. 6,893,850 B2) (hereinafter "Ostuni") in view with Clem, et al. (U.S. Patent No. 6,518,168 B1) (hereinafter "Clem").

Applicant believes that Ostuni is not applicable as a reference under 35 U.S.C. §102(e) and section 103(a). Applicant submits herewith a Declaration under 37 C.F.R. §1.131 and accompanying exhibits that establish reduction to practice of subject matter within each of claims 1-24 and 26-27 on or before the effective date of Ostuni, establishing an invention date for the invention as claimed that is on or before the effective date of Ostuni. (In addition to copies of the Declaration signed by the inventors, an unsigned copy has been included herewith for purposes of clarity.) It is noted that the Rule 131 Declaration establishes a date of invention of the subject matter of claims 1-24 and 26-27 prior to Ostuni's provisional filing date of March 17, 2000, since this can be readily demonstrated. Applicant does not concede that the provisional application of Ostuni, filed March 17, 2000, contains subject matter that creates a *prima facie* position of unpatentability of any of claims 1-24 and 26-27, nor does Applicant comment on any difference between the content of Ostuni's March 17, 2000 provisional relative to Ostuni's utility application specification filed March 15, 2001, and whether any such difference would affect the effective date of the Ostuni reference relative to claims 1-24 and 26-27. No such analysis or comparison is necessary since Applicant can demonstrate a date of completion of invention prior to Ostuni's earliest possible date of application as a reference. However, the lack of such comment by Applicant at this time should not be taken as a concession of any effective date of Ostuni. Accordingly, since Ostuni cannot be applied as a reference with respect to these claims, it is respectfully requested that the rejection of these claims be withdrawn in view of the non-availability of Ostuni.

With respect to claim 25, Applicant does not concede that the Declaration does not support the subject matter of this claim. The Applicant notes, however, that Ostuni does not teach or suggest a method of selectively depositing a material on a substrate including a contoured surface including a protrusion and a recess by applying a fluid having an advancing angle of less than about 90° as recited in claim 25. Therefore, even if one combined the teachings of Ostuni and Clem in the manner recited in the Office Action, all of the recited steps of claim 25 would not be taught or

suggested. Because the combination of Ostuni in view of Clem fails to teach or suggest each claim feature, claim 25 is patentable over Ostuni in view of Clem.

Accordingly, Applicant respectfully requests withdrawal of the rejections on this ground.

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Respectfully submitted,

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**REPLACEMENT SHEET FOR PAGE 24**

A method of patterning materials, such as proteins, on a contoured surface by depositing them onto protrusions on a surface, and a cell containment device that may be constructed by this method, are provided. The method may involve selectively depositing a material on a substrate including a contoured surface including protrusions and recesses. By applying a first fluid to the contoured surface and allowing the first fluid to distribute across only a portion of the contoured surface, a material may be deposited on the protrusions and not the recesses, or on the recesses and not the protrusions. Such a method may be used to selectively pattern cells or other materials on substrates.